

**REMARKS**

Claims 1-48 are pending in the application. Claims 1-34 have been canceled herein without prejudice. Claims 35 and 48 have been amended herein. Support for the claim amendment can be found throughout the application; no new matter has been added.

Importantly, the claim amendments and cancellations are being made solely to claim more clearly the invention and to expedite the prosecution of the instant application. The Applicants expressly reserve the right to further prosecute the same or similar claims in subsequent patent applications claiming the benefit of priority to the instant application. 35 U.S.C. § 120; and 35 U.S.C. § 121. Favorable consideration is respectfully requested in view of the foregoing amendments and following remarks.

**CLAIM REJECTIONS BASED ON 35 U.S.C. § 112 ¶1**

Claim 48 stands rejected under 35 U.S.C. § 112 ¶1 based on the Examiner's contention that the claim does not reasonably provide enablement for treating all diseases. The Applicants respectfully submit this response.

Solely to expedite prosecution, claim 48 has been amended to a method of treating or preventing cancer. The Applicants appreciate the Examiner indicating that they believe the specification of the instant application provides enablement for treating cancer.

Accordingly, based on the amendment to claim 48, the Applicants respectfully request the Examiner withdraw the claim rejections based on 35 U.S.C. § 112 ¶1.

**CLAIM REJECTIONS BASED ON 35 U.S.C. § 102(b)**

*WO 02/04544 to Barnette et al.*

Claims 35-48 stand rejected under 35 U.S.C. § 102(b) based on the Examiner's contention that the claims are anticipated by WO 02/04544 to Barnette et al. The Applicants respectfully traverse.

The Applicants respectfully remind the Examiner that in order to anticipate a claim, a single source must contain all of the elements of the claim. See Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); Atlas Powder Co. v. E.I. duPont De Nemours & Co., 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984); In re Marshall, 578 F.2d 301, 304, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. See Structural Rubber Prods. Co. v. Park Rubber Co., 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

The currently claimed polyphosphoester polymers of the instant application contain a polylactide monomer unit and an organophosphate. Solely to expedite prosecution, claim 35 has been amended to incorporate the structural limitation of formula 1, wherein L1 is the polylactide structure; L2 is the chemical moiety bonded through two -C(O)- radicals at its termini; and n and w independently of each other represent an integer equal to at least one. Furthermore, the currently claimed polyphosphoester polymer possesses an internal polymeric unit comprising a polylactide coupled to a -P(R)(O)- group. Critically, WO 02/04544 to Barnette et al. does not teach an internal repeating polymeric unit containing a polylactide structure attached to a -P(R)(O)- group. Therefore, WO 02/04544 to Barnette et al. does not teach all the limitations of the claims.

Accordingly, the Applicants respectfully request the Examiner withdraw the claim rejections under 35 U.S.C. § 102(b) based on WO 02/04544 to Barnette et al.

*Canadian Patent No. 597,473 to Werner et al.*

Claims 35-39 and 43-45 stand rejected under 35 U.S.C. § 102(b) based the Examiner contention that the claims are anticipated by Canadian Patent No. 597,473 to Werner et al. The Applicants respectfully traverse.

The Applicants respectfully remind the Examiner that in order to anticipate a claim, a single source must contain all of the elements of the claim. See Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); Atlas Powder Co. v. E.I. duPont De Nemours & Co., 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984);

In re Marshall, 578 F.2d 301, 304, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. See Structural Rubber Prods. Co. v. Park Rubber Co., 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

The currently claimed polyphosphoester polymers of the instant application contain a polylactide monomer unit and an organophosphate. As noted above, claim 35 has been amended to incorporate the structural limitation of formula 1, wherein L1 is the polylactide structure; L2 is the chemical moiety bonded through two -C(O)- radicals at its termini; and n and w independently of each other represent an integer equal to at least one. Furthermore, the currently claimed polyphosphoester polymer possesses an internal polymeric unit comprising a polylactide coupled to a -P(R)(O)- group. Critically, Canadian Patent No. 597,473 to Werner et al. does not teach an internal repeating polymeric unit containing a polylactide structure attached to a -P(R)(O)- group as claimed. Therefore, Canadian Patent No. 597,473 to Werner et al. does not teach all the limitations of the claims.

Accordingly, the Applicants respectfully request the Examiner withdraw the claim rejections under 35 U.S.C. § 102(b) based on Canadian Patent No. 597,473 to Werner.

#### **REJECTIONS BASED ON OBVIOUSNESS-TYPE DOUBLE PATENTING**

Claims 35-45 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6-11, 13-19, 21-25, 33, 35-38, 43, 47, 66, 70 and 73 of U.S. Patent No. 6,455,665 to Barnette et al. ("the '665 patent"). The Applicants respectfully request that the Examiner hold in abeyance all obviousness-type double patenting rejections based on the '665 patent until allowable subject matter is indicated, at which point the Applicants will file a terminal disclaimer if necessary.

#### **FEES**

The Applicants believe that they have provided for all required fees in connection with the filing of this Response. Nevertheless, the Commissioner is hereby authorized to charge any

additional fees due in connection with the filing of this Response to our Deposit Account, No. 06-1448, reference GPT-032.01.

### CONCLUSION

The Applicants believe that the pending claims are in condition for allowance. If a telephone conversation with Applicants' Agent would expedite prosecution of the above-identified application, the Examiner is urged to contact the undersigned.

Respectfully submitted,  
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